

REMARKS

Claims 1-3 and 5-39 are pending in the application. Of these, claims 1, 22, 23, and 30 are independent. Applicants request that this paper be entered. The claim listing is provided for the convenience of the Examiner although none of the claims are amended. Reconsideration of the pending claims in light of the following remarks is respectfully requested.

Amendments to the Specification

Applicants request that this paper be entered and that the specification be amended to replace paragraph [0186] of the filed application (paragraph [0191] of the published application) with the one included in this paper. This amended paragraph replaces a reference numeral 610 with the reference numeral 650, thereby conforming the paragraph reference numeral to the numerals in Fig. 39A.

Allowed and Allowable Claims

Applicants acknowledge the allowance of claims 23-25 and 27-29, and the allowability of claims 3, 9, 14, and 15. At page 5, the Office Action indicates that claim 26 also is allowed, however the Office Action also indicates that claim 26 is rejected under 35 U.S.C. §112, first paragraph.

Compliance with §112

The Office Action indicates that claims 1-3, 5-22, 26, and 30-39 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Office Action states that “Applicant fails to disclose first and second components that are triangular in shape. Although applicant is claiming first and second components that are triangular in shape, such limitations cannot be found in the specification.” Applicants traverse this rejection.

Applicants submit that all the claims of the application are fully supported by the specification, the drawings, and the claims as originally filed. At paragraph [0180] of the filed specification (paragraph [0185] of the published application), the application states,

In one embodiment, the support plate 610 is shaped in a triangular-like configuration to facilitate an oblique insertion approach from either the left or right side of the spine, and as such, includes side portions P1, P2 and P3. The side portions P1, P2 and P3 may take a variety of configurations including curved (illustrated by P2) or straight (illustrated by P1 and P3) configurations.

And at paragraph [0186] of the filed specification (paragraph [0191] of the published application), the application as amended above, continues

In one embodiment, the support plate 650 is shaped in a triangular-like configuration to facilitate an oblique insertion approach from either the left or right side of the spine, and as such, includes side portions P4, P5 and P6. The side portions P4, P5 and P6 may take a variety of configurations including curved (illustrated by P5) or straight (illustrated by P4 and P6) configurations.

Plates 610 and 650 are each shown in Figs. 39A, 39B, and 39C having a triangular configuration with respective side portions P1 – P6. Accordingly, the specification, drawings, and originally filed claims fully support the claim limitation of a component “triangular in shape.” Therefore, Applicants respectfully request that the Examiner withdraw the rejection.

Compliance with §103

Independent claim 1

The Office Action indicates that claims 1, 2, 5-8, 10-13, 16-19, 21, 22 and 30-39 are rejected under 35 U.S.C. §103(a) as being unpatentable over International Publication WO 03/039400 to Huppert et al. Applicant traverses this rejection on the grounds that this reference is defective in establishing a *prima facie* case of obviousness with respect to claim 1.

MPEP § 2142 states:

... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

Applicants submit that in the present case, a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be some expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. See MPEP § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As an initial matter, Huppert fails to teach or suggest all the limitation of claim 1, and therefore, a *prima facie* case of obviousness has not been established. In particular, Huppert fails to teach or suggest a prosthetic device for anterior-oblique insertion into an intervertebral space "wherein the first component is triangular in shape to define first, second and third side portions." In the Response to Amendment section of the Office Action, the Office Action asserts that the Applicants previously filed response argued a limitation that was not disclosed in the application, and that because of this, according to the Office Action, the Examiner felt compelled to reiterate the previous rejections of the claims. Office Action, page 5.

However, as discussed above, the claim recitation of "the first component is triangular in shape to define first, second and third side portions" is fully supported by the specification, drawings, and originally filed claims. Accordingly, the claim recitation carries patentable weight and Applicants respectfully request that the Examiner give the claim proper consideration, with all its recited limitations.

Furthermore, 35 U.S.C. §103 provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

(Emphasis added). Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since Huppert fails to teach or suggest a triangular shape as recited in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

The Office Action also states that the triangular shape “is nothing more than one of numerous configurations one of ordinary skill in the art would have found obvious” Office Action, page 4. However, as noted in the application specification, the triangular shape is not a mere design choice. Instead, the triangular shape of the component “facilitate[s] an oblique insertion approach from either the left or right side of the spine.” See Specification as filed, paragraphs 80 and 86. In the absence of any teaching or suggestion in Huppert of a “triangular in shape” component, the Office Action has not established a *prima facie* case of obviousness. Because Huppert fails to teach or suggest all the limitation of claim 1, claim 1 should be allowable over Huppert.

Each of independent claims 22 and 30 also recite “wherein the first component is triangular in shape to define first, second and third side portions.” Accordingly, these claims, like claim 1, should be allowable for at least the reasons discussed above.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of independent claims 1, 22, and 30.

Dependent Claims

Claims 2, 5-8, 10-13, 16-19, and 21, and claims 31-39 depend from independent claim 1 and independent claim 20 respectively and also are believed to be distinct from the art of record, for example for the same reasons discussed above with respect to the independent claims. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of these claims

Response to Amendment section in Office Action

In the Response to Amendment section, referring to the “triangular in shape” feature, the Office Action states that “Applicant stated that such limitation is crucial to the invention by facilitating an oblique insertion approach” Office Action, page 5. Applicants traverse this assertion. In the Amendment filed November 9, 2006, Applicants remarks did not include language indicating that the limitation was “crucial to the invention.” Any claims that do not recite the “triangular in shape” feature should not be construed later, such as during a litigation, or even during the prosecution process, to require a limitation of “triangular in shape.” In fact, Applicants submit that some claims directed to the invention should be allowable without any explicit or implicit limitation of “triangular in shape.”

Conclusion

For at least the reasons set forth above, Applicants submit that all the pending claims are in a condition for allowance. Accordingly, Applicants respectfully request that the Examiner reconsider and issue a formal notice of allowance.

Please grant any extension of time required to enter this response and charge any additional fees required by this paper to our Deposit Account No. 08-1394.

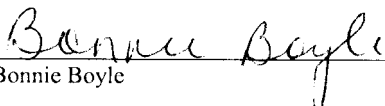
Respectfully submitted,



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I hereby certify that this correspondence is being filed with the U.S. Patent and Trademark Office via EFS-Web on <u>February 20, 2007</u> .
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